

1FW

PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/789,561	
	Filing Date	27 February 2004	
	First Named Inventor	Beaucage	
	Art Unit	3729	
	Examiner Name	Kim, Paul D.	
Total Number of Pages in This Submission	5	Attorney Docket Number	HSJ9-2003-0128US1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div>Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	John J. Oskorep, Esq.
Signature	
Date	28 September 2006

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	John J. Oskorep, Esq.		
Signature		Date	28 September 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
<i>Beaucage</i>)	Art Unit: 3729
)	
Serial No.: 10/789,561)	Examiner: Kim, Paul D.
)	
Filed: 02/27/2004)	Docket No.: HSJ9-2003-0128US1
)	

For: *METHODS AND APPARATUS FOR CONTROLLING THE LAPPING OF
A SLIDER BASED ON AN AMPLITUDE OF A READBACK SIGNAL
PRODUCED FROM AN EXTERNALLY APPLIED MAGNETIC FIELD*

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

In response to the Restriction Requirement mailed on 28 August 2006,
please consider the following:

In the mailing of 28 August 2006, a Restriction Requirement was issued for the above-referenced patent application. In the restriction requirement, the Examiner separated the claims of the present application into two groups, namely, Group I "method" claims 1-9 and 18-22, and Group II "system" claims 10-17 and 23-27.

In the restriction, the Examiner states that Groups I and II are distinct because "the process as claimed can be practiced by another and materially different apparatus or by hand." The Applicants respectfully disagree and hereby traverse the Examiner's restriction. More specifically, the Applicants respectfully submit that the process could not be practiced by any materially different apparatus or by hand. When "lapping" of a slider is performed as recited in the method claims, for example, one of ordinary skill in the art appreciates that it requires the use of a lapping plate as recited in the system claims. As another example, in order to "produce a magnetic field" around the slider, a coil is needed as recited in the system claims. The Examiner even suggests that the production of the magnetic field can be performed by hand, but it obviously cannot be so produced.

With respect to the requirement to elect one of species A and B of Group I, or species C and D of Group II, the Applicants further disagree. A measurement of the asymmetry makes use of a readback signal amplitude. See e.g. claims 9, 17, 22, and 29. Therefore, species B and D are merely narrower embodiments than species A and C, respectively.


These are but a few examples of the reasons why the Examiner's restriction requirement is not proper. The Applicants respectfully request the Examiner to withdraw such restriction.

In any event, the Applicant hereby elects *GROUP II invention claims 10-17 and 23-27* with traverse, with further election of species C.

Thank you. The Examiner is invited to contact the undersigned by telephone if necessary to expedite this matter.

Date: 28 Sept 2006

Respectfully Submitted,



JOHN J. OSKOREP
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 NORTH MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611

Telephone: (312) 222-1860 Fax: (312) 475-1850